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3621

**CERTIFICATE OF MAILING UNDER 37 C.F.R. §1.8**

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, with sufficient postage, in an envelope addressed to: Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450, on the below date:

Date: February 22, 2005 Name: Tadashi Horie Reg. No. 40,437 Signature: Tadashi Horie

**BRINKS  
HOFER  
GILSON  
& LIONE**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Appln. of: Shuji SASAKI  
Yuuji YOSHIDA  
Yukikazu KURODA

Appln. No.: 10/037,293

Filed: December 21, 2001

For: SETTLEMENT PROCESSING METHOD AND  
SETTLEMENT PROCESSING SYSTEM

Attorney Docket No: 9683/98

Examiner: ABDI, Kambiz

Art Unit: 3621

Mail Stop Amendment  
Commissioner for Patents  
P. O. Box 1450  
Alexandria, VA 22313-1450

**TRANSMITTAL**

Sir:

Attached is/are:

Fourth Supplemental Information Disclosure Statement, Copy of Canadian Office Action, Form PTO-1449, 2 Cited References (E1 and E2)  
 Return Receipt Postcard

Fee calculation:

No additional fee is required.  
 Small Entity.  
 An extension fee in an amount of \$\_\_\_\_\_ for a \_\_\_\_\_-month extension of time under 37 C.F.R. § 1.136(a).  
 A petition or processing fee in an amount of \$\_\_\_\_\_ under 37 C.F.R. § 1.17(\_\_\_\_).  
 An additional filing fee has been calculated as shown below:

	Claims Remaining After Amendment		Highest No. Previously Paid For	Present Extra	Rate	Add'l Fee	or	Rate	Not a Small Entity
Total		Minus			x \$25=			x \$50=	
Indep.		Minus			x 100=			x \$200=	
First Presentation of Multiple Dep. Claim					+\$180=			+\$360=	
					Total	\$	Total	\$	

Fee payment:

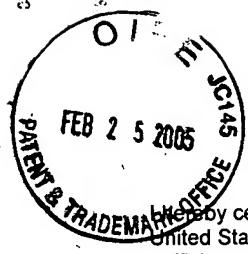
A check in the amount of \$\_\_\_\_\_ is enclosed.  
 Please charge Deposit Account No. 23-1925 in the amount of \$\_\_\_\_\_. A copy of this Transmittal is enclosed for this purpose.  
 Payment by credit card in the amount of \$\_\_\_\_\_ (Form PTO-2038 is attached).  
 The Director is hereby authorized to charge payment of any additional filing fees required under 37 CFR § 1.16 and any patent application processing fees under 37 CFR § 1.17 associated with this paper (including any extension fee required to ensure that this paper is timely filed), or to credit any overpayment, to Deposit Account No. 23-1925.

Respectfully submitted,

  
Tadashi Horie (Reg. No. 40,437)

February 22, 2005

Date



**CERTIFICATE OF MAILING**

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope, with sufficient postage, addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on

February 22, 2005

Date of Deposit

Tadashi Horie Reg. No. 40,437

Name of Applicant, Assignee or  
Registered Representative

Signature

February 22, 2005

Date of Signature

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Appln. of: Shuji SASAKI  
Yuuji YOSHIDA  
Yukikazu KURODA

Appln. No.: 10/037,293

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PROCESSING SYSTEM

Attorney Docket No: 9683/98

Examiner: ABDI, Kambiz

Art Unit: 3621

**FOURTH SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT**

In accordance with the duty of disclosure under 37 C.F.R. §1.56 and §§1.97-1.98, and more particularly in accordance with 37 C.F.R. §1.97(c), Applicants hereby cite the following references:

FOREIGN DOCUMENT NUMBER <small>Number-Kind Code (if known)</small>	DATE	COUNTRY
EP 1 016 999 A2	07/05/2000	EPO
EP 0 869 692 A1	10/07/1998	EPO

Applicants are enclosing Form PTO-1449 (one sheet), along with a copy of each listed reference for which a copy is required under 37 C.F.R. §1.98(a)(2). As each of

the listed references is in English, no further commentary is believed to be necessary, 37 C.F.R. §1.98(a)(3). The listed references were cited in an Office Action issued in the counterpart Canadian application. A copy of the Office Action is attached to this Statement. Applicants respectfully request the Examiner's consideration of the above references and entry thereof into the record of this application.

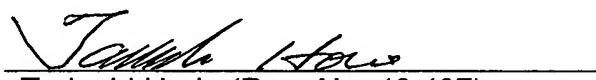
By submitting this Statement, Applicants are attempting to fully comply with the duty of candor and good faith mandated by 37 C.F.R. §1.56. As such, this Statement is not intended to constitute an admission that any of the enclosed references, or other information referred to therein, constitutes "prior art" or is otherwise "material to patentability," as that phrase is defined in 37 C.F.R. §1.56(a).

The Canadian Office Action is dated January 18, 2005. For purposes of 37 C.F.R. §1.704(d), Applicants certify that each item of information contained in this Statement was cited in a communication from a foreign patent office in a counterpart application, and that this communication was not received by any individual designated in 37 C.F.R. §1.56(c) more than thirty days prior to the filing of this Statement.

Applicants certify under 37 C.F.R. §1.97(e)(1) that no item of information in this Statement was first cited in any communication from a foreign patent office in a counterpart foreign application more than three months prior to the filing of this Statement. Accordingly, Applicants have calculated no fee to be due in connection with the filing of this Statement. However, the Director is authorized to charge any fee deficiency associated with the filing of this Statement to a deposit account, as authorized in the Transmittal accompanying this Statement.

Respectfully submitted,

February 22, 2005  
Date

  
Tadashi Horie (Reg. No. 40,437)



FORM PTO-1449 TRADEMARK OFFICE	SERIAL NO. 10/037,293	CASE NO. 9683/98
LIST OF PATENTS AND PUBLICATIONS FOR APPLICANT'S FOURTH SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT (use several sheets if necessary)		FILING DATE December 21, 2001
APPLICANT(S): Shuji SASAKI et al.		

**REFERENCE DESIGNATION** **U.S. PATENT DOCUMENTS**

EXAMINER INITIAL	DOCUMENT NUMBER Number-Kind Code (if known)	DATE	NAME	CLASS/ SUBCLASS	FILING DATE
E					
E					
E					
E					
E					
E					

**FOREIGN PATENT DOCUMENTS**

EXAMINER INITIAL	DOCUMENT NUMBER Number-Kind Code (if known)	DATE	COUNTRY	CLASS/ SUBCLASS	TRANSLATION YES OR NO
E1	EP 1 016 999 A2	07/05/2000	EPO		
E2	EP 0 869 692 A1	10/07/1998	EPO		
E					
E					
E					

EXAMINER INITIAL	OTHER ART - NON PATENT LITERATURE DOCUMENTS (Include name of author, title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date page(s), volume-issue number(s), publisher, city and/or country where published.)	
E		
E		
E		
E		

EXAMINER	DATE CONSIDERED
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EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.



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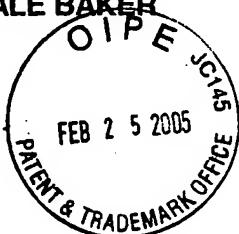
January 18, 2005

KIRBY EADES GALE BAKER

Box 3432  
Station D  
OTTAWA Ontario  
K1P 6N9

ENTERED \_\_\_\_\_

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**COPY**

**Application No.** : 2,364,304  
**Owner** : NTT DOCOMO, INC.  
**Title** : SETTLEMENT PROCESSING METHOD AND SETTLEMENT  
PROCESSING SYSTEM  
**Classification** : H04B-7/185  
**Your File No.** : 47251  
**Examiner** : Jennifer L. Guerra

**YOU ARE HEREBY NOTIFIED OF A REQUISITION BY THE EXAMINER IN ACCORDANCE  
WITH SUBSECTION 30(2) OF THE PATENT RULES. IN ORDER TO AVOID ABANDONMENT  
UNDER PARAGRAPH 73(1)(A) OF THE PATENT ACT, A WRITTEN REPLY MUST BE  
RECEIVED WITHIN 6 MONTHS AFTER THE ABOVE DATE.**

This application has been examined taking into account applicant's correspondence received in this office on September 16, 2004.

The number of claims in this application is 2.

The following documents were identified by word searching in the Techsource and Delphion data bases and on the Internet. The search of the prior art has revealed the following:

**References applied**

United States Patent

5,280,625 □ Jan. 18, 1994 G06F 13/00 HOWARTER et al.

European Patent Office Applications

1 016 999 □ Jul. 5, 2000 G06F 17/60 OGASAWARA  
0 869 692 Oct. 7, 1998 H04Q 7/38 GOERKE

Canada

O P I C  C I P O

citation stemming from a foreign search report

HOWARTER et al. disclose a satellite wide area communications network for financial transactions in which multiple transaction card readers are linked to host computers via a satellite link. The transaction card readers interface to a modem unit, and transaction information is then communicated across a satellite network to a master transmitter/receiver. The master transmitter/receiver then distributes the information to a destination host computer for processing.

OGASAWARA discloses an electronic shopping system in which a server obtains a customer's telephone number, and then searches a customer information database for that telephone number. If the number is found in the database, then the server assumes that an authorized customer is placing the call (column 5).

GOERKE discloses user authentication across multiple telecommunications networks in which an authentication centre stores an identification code for each registered subscriber to the network. This identification code is then compared to the identification code in a user terminal for authentication of the user terminal (columns 1 and 4).

#### **Obviousness**

HOWARTER et al. teach a satellite communication network for transmitting financial transaction data from transaction card readers to host computers containing card specific data required for the financial transaction. A card is swiped at the card reader, and an operator uses a keyboard on the transaction card reader to input additional information relating to the transaction. A remote satellite transmitter/receiver transmits information relating to a sales transaction to the satellite, which then transmits the information to a communications network. The information is then received by a host computer (settlement unit) for processing (figure 1).

HOWARTER et al. do not teach maintaining a database for storing identification codes of the card reader terminals at the settlement unit, however, both OGASAWARA and GOERKE teach maintaining a customer information database or an identification code database at a central location for authentication of user terminals.

It would have been obvious to a person skilled in the art to incorporate the identification code databases of one of OGASAWARA or GOERKE in the network of HOWARTER et al.

Claims 1 to 2 do not comply with section 28.3 of the *Patent Act* as the subject matter of the claims would have been obvious having regard to the satellite communication network for transmitting financial transaction data from transaction card readers as disclosed by HOWARTER et al. in view of the identification code databases of one of OGASAWARA or GOERKE.

### **New matter**

The amendment to claims 1 and 2, made on September 16, 2004, contains new matter which goes beyond the content of the application as originally filed. The statement that a communication request is made to a “*requested communication destination*” is not supported by the original disclosure. The new matter must be removed in order to comply with section 38.2 of the *Patent Act*.

### **Indefiniteness**

The term “the card settlement service” (claim 1, lines 14 to 15) has no antecedent.

Claim 1 is directed to a settlement unit which comprises “a database”. An abstract item such as a database cannot be considered to be a machine, or a component of a system. In order to elevate the database from an abstract idea to a machine, or a component of a system, software must be claimed as the medium embodying the program in a material or physical form.

Claim 2 is dependent upon claim 1 and fails to overcome the objections made for that claim.

For the above reasons, claims 1 and 2 are indefinite and do not comply with subsection 27(4) of the *Patent Act*.

In view of the foregoing defects, the applicant is required, under subsection 30(2) of the *Patent Rules*, to amend the application in order to comply with the *Patent Act* and the *Patent Rules* or to provide arguments as to why the application does comply.

Jennifer L. Guerra, P. Eng  
Patent Examiner  
(819) 934-2628  
2364304A.jg